



28 FEB 2006

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Fitch Even Tabin & Flannery  
120 South LaSalle Street  
Suite 1600  
Chicago IL 60603-3406

In re Application of BIRD et al.

Application No.: 10/523,153

PCT No.: PCT/AU03/00954

Int. Filing: 29 July 2003

Priority Date: 29 July 2002

Attorney Docket No.: 83950

For: A BULK COMMUNICATIONS PROCESS  
USING MULTIPLE DELIVERY MEDIA

: DECISION ON PETITION

: UNDER 37 CFR 1.47(a) and

: 37 CFR 1.182

This is a decision on applicant's petition under 37 CFR 1.47(a), filed in the United States Patent and Trademark Office (USPTO) on 06 October 2005, to accept the application without the signatures of joint inventors, Kevin Bryan Levine and Michael Robert Stewart. Applicant's request for a three month extension of time is granted.

### **BACKGROUND**

On 27 January 2005, applicant filed a transmittal letter (PTO-1390) requesting entry into the national stage in the United States of America under 35 U.S.C. §371. Filed with the Transmittal Letter was, *inter alia*, the requisite basic national fee. The transmittal letter was directed to PCT/US03/00954; however, applicant submitted a copy of international application PCT/AU03/00954. The submission was treated as a national stage application of PCT/US03/00954 and assigned U.S. application number 10/523,153.

On 09 May 2005, a Notification of Missing Requirements (FORM PCT/DO/EO/905) was mailed to applicant indicating *inter alia*, that an oath or declaration in accordance with 37 CFR 1.497(a) and (b) and the surcharge for filing the oath or declaration after the thirty month period was required.

On 06 October 2005, applicant filed the instant petition along with a declaration directed to PCT/AU03/00954, executed by the joint inventors on behalf of the nonsigning inventors. The petition under 37 CFR 1.47(a) in an attempt to satisfy the requirements of 35 U.S.C. 371(c)(4) requested the acceptance of the application without the signatures of inventors Kevin Bryan Levine and Michael Robert Stewart, alleging that the inventors refuse to sign the application.

### **DISCUSSION**

At the outset, it is noted that on 27 January 2005, applicant submitted a transmittal letter requesting a filing under 35 U.S.C. 371 (Form PTO-1390) directed to PCT/US03/00954. However, applicant supplied a copy of international application PCT/AU03/00954. Pursuant to

37 CFR 1.182 and applicant's authorization to charge any necessary fees, the PCT application number on the transmittal letter and papers filed on 27 January 2005 will be corrected to PCT/AU03/00954, and be treated as the national stage application of PCT/AU03/00954, assigned U.S. application number 10/523,153. Applicant's deposit account will be charged the requisite \$400 petition fee.

Petition under 37 CFR 1.47(a)

A petition under 37 CFR §1.47(a) must be accompanied by (1) the fee under 37 CFR §1.17(g), (2) factual proof that the non-signing joint inventor(s) refuses to execute the application or cannot be reached after diligent effort, (3) a statement of the last known address of the non-signing inventor(s), and (4) an oath or declaration by each available joint inventor on his or her own behalf and on behalf of the non-signing joint inventor(s).

The petition included authorization to charge applicant's deposit account the requisite petition fee of \$200, satisfying Item (1). Item (3) is satisfied because the last known addresses of non-signing inventors were provided. With regard to item (4), the declaration executed by the available joint inventors on their behalf and on behalf of the non-signing inventors was submitted and satisfies this requirement of 37 CFR 1.47(a).

Inventors' Refusal to Sign

With respect to Item (2) above, statements of facts by Frank Anthony Favretto, Chairman of the Board of Trustees of Trade Wind Communications Limited and by Neville Zammit, Secretary of Trade Wind Communications Limited regarding the inventors' refusal to sign the application were presented. Mr. Favretto states that he met with Michael Robert Stewart on 1 June 2005 to "pursue the execution of the US declaration and the execution of an assignment for the purposes of the US application." (§11-12) Mr. Favretto states that "Mr. Stewart declined to execute the US declaration or assignment." (§13) Mr. Favretto makes no indication that Mr. Stewart was presented with a copy of the patent application along with declaration.

Likewise, with respect to Mr. Levine's refusal to join the application, Neville Zammit states in his declaration that he "called Mr. Levine on 20 May 2005 and asked him to sign the US declaration and an assignment for the purposes of the US application" (§4). Mr. Levine responded that "he did not want to execute the US declaration or any assignment" but that he "would think it over and get back" to Mr. Zammit. (§5) Mr. Zammit called Mr. Levine on May 24, 25 and 26, 2005 leaving a message each time and sent a follow-up email to obtain Mr. Levine's response. (§6) On 06 June 2005, Mr. Levine left a voice message indicating that he believed "he was owed money by the company and wanted to be pay something if he signed". Mr. Zammit states that he confirmed that no money is owed to Mr. Levine and that Trade Wind Communications is not aware of any claim by Mr. Levine that it owes money to him. (§7) Mr. Zammit makes no indication that he conveyed this information regarding the payment of any money to Mr. Levine, nor does Mr. Zammit indicate that Mr. Levine was presented with a complete copy of the application papers.

Petitioner has not provided evidence that a complete copy of the application papers, including specification, claims and drawings and declaration, were provided to Mr. Stewart or Mr. Levine. What is required is that both Mr. Stewart and Mr. Levine be presented with a copy of all of the national stage application papers (specification, including claims and drawings, oath or declaration) for this application. *Where a refusal of the inventor to sign the application papers is alleged, the circumstances of the presentation of the application papers and of the refusal must be specified in a statement of facts by the person who presented the inventor with the application papers and/or to whom the refusal was made.* Statements by a party not present when an oral refusal is made will not be accepted. See Section 409.03(d) of the Manual of Patent Examining

Procedure (MPEP), Proof of Unavailability or Refusal.<sup>1</sup>

In sum, Petitioner has satisfied Items (1), (3) and (4) above. However, Petitioner has not satisfied Item (2) by demonstrating: (1) a *bona fide* attempt was made to present a copy of the application papers for U.S. application 10/523,153 (specification, including claims, drawings, and declaration) to the nonsigning inventors for their signature and both Mr. Stewart's and Mr. Levine's refusal to sign, either in writing or by telephone, these documents. Accordingly, it is inappropriate to accord the national stage application status under 37 CFR §1.47(a) at this time.

### CONCLUSION

The petition under 37 CFR §1.47(a) is **DISMISSED WITHOUT PREJUDICE**.

Any reconsideration on the merits of the petition under 37 CFR §1.47(a) must be filed within TWO (2) MONTHS from the mail date of this decision. Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR §1.47(a)." No petition fee is required. Any further extensions of time available may be obtained under 37 CFR 1.136(a).

Any further correspondence with respect to this matter should be addressed to the Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.

  
Cynthia M. Kratz  
Attorney Advisor  
PCT Legal Office

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<sup>1</sup> A refusal by an inventor to sign an oath or declaration when the inventor has not been presented with the application papers does not itself suggest that the inventor is refusing to join the application unless it is clear that the inventor understands exactly what he or she is being asked to sign and refuses to accept the application papers. A copy of the application papers should be sent to the last known address of the nonsigning inventor, or, if the nonsigning inventor is represented by counsel, to the address of the nonsigning inventor's attorney.... It is reasonable to require that the inventor be presented with the application papers before a petition under 37 CFR 1.47 is granted since such a procedure ensures that the inventor is apprised of the application to which the oath or declaration is directed. *In re Gray*, 115 USPQ 80 (Comm'r Pat. 1956).

Where a refusal of the inventor to sign the application papers is alleged, the circumstances of the presentation of the application papers and of the refusal must be specified in a statement of facts by the person who presented the inventor with the application papers and/or to whom the refusal was made. Statements by a party not present when an oral refusal is made will not be accepted. Proof that a *bona fide* attempt was made to present a copy of the application papers (specification, including claims, drawings, and oath or declaration) to the nonsigning inventor for signature, but the inventor refused to accept delivery of the papers or expressly stated that the application papers should not be sent, may be sufficient. When there is an express oral refusal, that fact along with the time and place of the refusal must be stated in the statement of facts. When there is an express written refusal, a copy of the document evidencing that refusal must be made part of the statement of facts. The document may be redacted to remove material not related to the inventor's reasons for refusal.

When it is concluded by the 37 CFR 1.47 applicant that a nonsigning inventor's conduct constitutes a refusal, all facts upon which the conclusion is based should be stated in a statement of facts in support of the petition or directly in the petition. If there is documentary evidence to support facts alleged in the petition or any statement of facts, such evidence should be submitted. Whenever a nonsigning inventor gives a reason for refusing to sign the application oath or declaration, that reason should be stated in the petition.

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Office of PCT Legal Administration

Telephone: (571) 272-3286  
Facsimile (571) 272-0459